

REMARKS

The Amendments

Claim 1 is amended to remove the recitation of H as an option for R¹. The other variables which previously recited groups of R¹ are amended to add the H option since it is no longer included by reference to R¹. Thus, the definition of these other variables is unchanged. Claim 1 is further amended to add the proviso at the end of the claim. This proviso is supported, for example, by the recitation at page 14, paragraph [0035], exemplifying preferences for alkyl groups not having an aryl group for R¹.

To the extent that the amendments avoid the prior art or for other reasons related to patentability, competitors are warned that the amendments are not intended to and do not limit the scope of equivalents which may be asserted on subject matter outside the literal scope of any patented claims but not anticipated or rendered obvious by the prior art or otherwise unpatentable to applicants. Applicants reserve the right to file one or more continuing and/or divisional applications directed to any subject matter disclosed in the application which has been canceled by any of the above amendments.

The Restriction Requirement

Applicants maintain their traversal of the restriction requirement and also traverse the application of the election of species requirement.

In response to the Election of Species requirement, applicants had elected formula Ia of claim 14. The Office Action alleges that only claims 1-6, 10, 11 and 14-15 read on the elected species. Applicants urge, however, that claims 9, 12 and 13 (of elected Group I) also read on this species. The required presence of P-Sp- groups for the compounds in these claims does not remove them from being within formula Ia of claim 14. Formula Ia of claim

14 does not provide any further requirement for the R¹ group therein and the definition of R¹ in claim 1 includes P-Sp- groups. Further, formula Ia does not require any particulars of the right and left terminal groups (R⁴ and R⁵ in formula II, claim 2) and, thus, the formula encompasses when such groups are P-Sp-. Accordingly, claims 9, 12 and 13 also read on the elected species.

Regarding the restriction of Group II, claims 16-27, from Group I, claims 1-15, applicants' maintain their traversal. The alleged basis for maintaining the requirement in the Office Action does not comply with PTO rules and regulations for requiring restriction. Further, the alleged basis for maintaining the requirement in the Office Action mischaracterizes applicants' prior traversal of the restriction requirement. Applicants' never alleged there was no separate search requirement. But mere separate classification and further search requirement does not support a restriction requirement. Applicants' arguments were based on failure to establish proper restriction in the instant situation where the claims of Group I and Group II are related as subcombination/combination. These arguments are summarized again, as follows, so that they will be addressed.

The standard for restriction in this case is set forth in MPEP §806.05(c). The non-elected claims 16-27 are directed to compositions, polymers, etc., which contain or are derived from a monomer, oligomer, or polymer of claims 1-15, and some other component. These Group II combinations, as claimed, require the particulars of the subcombination Group. Each of claims 16-27 ultimately depends upon claim 1, and, thus, by definition as dependent claims, they must require the particulars of claim 1. To put it another way, if claim 1 is allowable, claims 16-27 should also be allowable because they contain an embodiment of claim 1 as a component. Accordingly, the first prong of the basis for restriction under MPEP §806.05(c) is not met and the restriction requirement herein is not

supported. The current Office Action failed to address these same points made by applicants in the initial response to the restriction requirement. If the restriction is to be maintained, applicants strongly urge that their arguments at least be addressed. Otherwise, the requirement should be withdrawn.

The Rejection under 35 U.S.C. §102

The rejection of claims 1-6, 10, 11 and 14-15 under 35 U.S.C. §102(b), as being anticipated by Chem Abstract 135:153178 ("Hayashi") or Chem Abstract 130:197214 ("Salzner") is respectfully traversed.

Hayashi discloses phenylacetylene thiophene compounds or polymers having $-C\equiv C-Ph$ substituents. The monomers, oligomers or polymers of applicants' formula I of claim 1 do not encompass such compounds. Compare the proviso at the end of currently amended claim 1 -- upon which all other claims ultimately depend. Thus, Hayashi does not meet all elements of the claims and does not anticipate the instant claims.

Salzner discloses thiophene compounds having $-C\equiv C-H$ substituents. The monomers, oligomers or polymers of applicants' formula I of claim 1 do not encompass such compounds. Compare the definition of R^1 in the currently amended claim 1 -- upon which all other claims ultimately depend. Thus, Salzner does not meet all elements of the claims and does not anticipate the instant claims.


For the above reasons, it is urged that the rejection of the claims under 35 U.S.C. §102(b) should be withdrawn. Further, the Hayashi and Salzner references would not support a rejection under 35 U.S.C. §103. The abstracts indicate no utility for the compounds disclosed therein. Where a reference discloses no utility for compounds disclosed therein, the reference provides no motivation to one of ordinary skill in the art to modify such compounds

even to compounds which are allegedly structurally similar. In re Stemniski, 170 USPQ 343 (CCPA 1971).

It is submitted that the claims are in condition for allowance. However, the Examiner is kindly invited to contact the undersigned to discuss any unresolved matters.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,



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